

REMARKS

This amendment is in response to the Office Action of May 5, 2004 in which claims 1-22 were rejected. Claims 1-22 have been cancelled and new claims 23 to 36 have been added. For the information of the Examiner, the enclosed new claims are based on a suggestion of the Examiner during the International Phase.

The new independent claim 1 is based on the original claims 1, 2, 9, 10 and 11, and the new independent method claim is based on the original dependent claims 12, 19, 20 and 21. The remaining dependent claims were correspondingly renumbered.

The object underlining the present invention (see page 2, line 34 through page 3, line 2) is to provide a network system and a method by which a data rate change is performed seamlessly even between two different networks.

This object is solved by the network system according to claim 1, and by the method according to claim 8 where it is claimed that the terminal, the network control unit and the interworking means (between two networks) work together to perform a data rate change by means of the fill/delete bits.

This is neither shown nor suggested by the cited prior art documents.

The primary reference WO 97/12490 (Rasanen), discloses a mobile communication system comprising a DTE, MS, BTS, BSC, and MSC connected to a PSTN/ISDN. A data rate between different elements (e.g., an IWF modem and a PSTN modem) is negotiated during setup, as described for instance on page 14, lines 14 to 17. Although WO 97/12490 may disclose two different networks and

The secondary reference to Chung et al. discloses a rate adapter which adapts the data rate by means of stuff bits or delete bits in each frame, as described in column 4, lines 34-48 and illustrated in Fig. 6, for example. This document describes how a data rate can be changed by means of fill/delete bits but does not suggest that this could be applied to two different networks.

In contrast to the prior art documents, in the present application a second network is involved and the adaptation of the data rates takes place on the transition from the first network to the other. That is, in contrast to the prior art network systems, high speed data traffic is not conveyed by existing traffic channels in the same network, but a transition between two different networks involving different data rates has to be handled.

The Examiner states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a system that adds/deletes fill data such as that suggested by Chung, in the system of Rasanen. The motivation for making this modification, according to the Examiner, is because fill data allows the terminal to know if a data rate is changed according to the request and further to adjust the data rate according to the change.

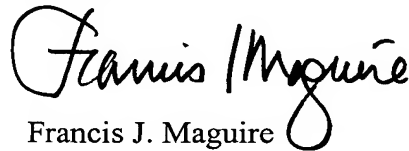
However, according to the MPEP and relevant case law in order to explain why the proposed modification would be obvious the Patent Office must identify where the **prior art** provides a motivating suggestion to make the modification proposed by the Examiner. See for instance *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). The mere fact that the prior art may be modified as suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification, *In re Fritch*, 922 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Examiner does not show or point to anything from the two references themselves that supplies the requisite motivation.

It is therefore appropriate that the Examiner not apply any new obviousness rejection against the new claims 23-26 because they have been constituted in such a way as to distinguish over the prior art applied by the Examiner, as explained above.

The objections and rejections of the Office Action of May 5, 2004, having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of claims 23-36 to issue is solicited.

Respectfully submitted,

A handwritten signature in black ink, reading "Francis J. Maguire". The signature is written in a cursive style with a large, stylized "F" and "M".

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